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IN THE

Supreme Court of the United States

October Term, 1974

THE DUPLAN CORPORATION, ET AL.,

Petitioners,

v.

MOULINAGE ET RETORDERIE DE CHAVANOZ,

Respondent.

On Petition for a Writ of Certiorari to the
United States Court of Appeals for the Fourth Circuit

BRIEF FOR RESPONDENT IN OPPOSITION

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Fed. R. Civ. P. 26(b)(3) ..... *passim*

IN THE

Supreme Court of the United States

October Term, 1974

No. 74-946

THE DUPLAN CORPORATION, ET AL.,
Petitioners,

v.

MOULINAGE ET RETORDERIE DE CHAVANOZ,
Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Fourth Circuit

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BRIEF FOR RESPONDENT IN OPPOSITION

Preliminary Statement

Petitioners seek review of an interlocutory order denying them discovery of 21 documents and ordering further consideration of those documents by the district court. The principal effect of such review would be substantial delay in the trial of 37 consolidated patent-antitrust cases, some of which have been pending for more than six years.

The court of appeals held that the district court had failed, in ordering production of the 21 documents, to

"protect against disclosure of the mental impressions, conclusions, opinions, or legal theories of an attorney or other representative of a party concerning the litigation" as required by Rule 26(b)(3) of the Federal Rules of Civil Procedure. In so holding, the court of appeals adopted an interpretation of this language that is compelled by the text of the Rule itself, and is consistent with every reported court of appeals and district court decision since the Rule was enacted in 1970. The holding of the court of appeals—that Rule 26(b)(3) confers unqualified immunity from discovery upon the mental impressions, conclusions, opinions, and legal theories of counsel and others—is not sufficiently doubtful or disputed to warrant review by this Court.

Even if this Court were disposed to consider whether the protection afforded by the second sentence of Rule 26(b)(3) is unqualified, this case is not an appropriate vehicle for such consideration, because the decision below may be supported on an independent ground.

Rule Involved and Decisions Below

Fed. R. Civ. P. 26(b)(3) is set forth at page 3 of the petition. The decisions below are annexed to the petition as an appendix.

Question Presented

Did the court of appeals err in holding that the district court's interlocutory order directing discovery of 21 documents failed to "protect against disclosure of the mental impressions, conclusions, opinions, or legal theories" of

attorneys and other parties' representatives concerning litigation, as required by Fed. R. Civ. P. 26(b)(3), and in remanding the case to the district court for further consideration as to whether redacted or abstracted versions of the documents should be produced?

Statement of the Case

Respondent, Moulinage et Retorderie de Chavanoz ("Chavanoz"), is the owner of several United States patents on apparatus and processes for texturing yarns by the false twist method. Chavanoz has licensed Deering Milliken Research Corporation ("DMRC") to sublicense the use of the patented inventions in the United States.

Petitioners entered into patent license agreements with DMRC at various times. Beginning in 1968, petitioners stopped paying the agreed royalties. DMRC then commenced actions for breach of the license agreements and for patent infringement. Chavanoz was made a party by petitioners and has subsequently joined DMRC as a plaintiff. In answers and counterclaims, and in independent actions of their own, petitioners allege that DMRC, Chavanoz, and others have violated the antitrust laws, and that the patents in suit have been misused, are invalid, and are not infringed. In all, 37 actions involving Chavanoz were brought in four district courts: those originating elsewhere were transferred to the United States District Court for the District of South Carolina pursuant to 28 U.S.C. §1404, where the actions were consolidated.[1]

1. The first complaint was filed on August 8, 1968, and the most recent on March 29, 1971.

Extensive—indeed, seemingly endless—discovery and other pretrial proceedings have taken place. There have been 122 days of depositions, involving 78 witnesses, during which more than 2,000 pretrial exhibits were marked; over 1,000,000 documents have been produced; 16 sets of interrogatories and requests for admissions containing more than 350 separate questions or propositions have been served and responded to.

This petition arises from petitioners' attempt to obtain 21 more documents—all of which, it is undisputed, were prepared in anticipation of litigation or for trial and contain mental impressions, conclusions, opinions, or legal theories of attorneys or other representatives of Chavanoz.[2] The documents in dispute, which include legal memorandums, drafts of briefs, and the like were prepared for Chavanoz in connection with prior patent litigations in the United States and Europe.

The discovery dispute which petitioners seek to bring to this Court has a complex history of its own, beginning almost two years ago.

In an order filed May 9, 1973, the district court granted petitioners discovery of certain trial preparation materials, without regard to need or hardship; the district court held that the protection afforded by Fed. R. Civ. P. 26(b)(3) disappears when the litigation for which the materials were prepared is ended. *Duplan Corp.* v. *Deering Milliken, Inc.*, 61 F.R.D. 127 (D.S.C. 1973). On interlocutory appeal, this ruling by the district court was reversed by the Court of

2. The order below should control the district court's rulings on additional work product documents that are now under consideration.

Appeals for the Fourth Circuit, which remanded the matter to the district court for further consideration of whether petitioners had made the showing of substantial need and undue hardship specified in Rule 26(b)(3). *Duplan Corp. v. Moulinage et Retorderie de Chavanoz*, 487 F.2d 480 (4th Cir. 1973).

Petitioners sought and obtained an extension of 60 days within which to file a petition for certiorari seeking to review the court of appeals' 1973 decision. See No. A-684, Jan. 17, 1974. However, they never filed the petition.

On remand, the district court ordered production of some of the documents, and denied discovery of others in decisions dated December 21, 1973 and February 5, 1974.[3] However, in ordering production of some of these trial preparation materials the district court did not—and did not purport to—"protect against disclosure of the mental impressions, conclusions, opinions, or legal theories of an attorney or other representative of a party concerning the litigation." The district court held that the Rule's protection of mental impressions, conclusions, opinions, and legal theories ("opinion work product," for short) does not apply to materials prepared for prior litigations, and that discovery of such matter is available in a subsequent action upon the same showing that will permit discovery of ordinary work product that does not contain opinion.

On a second interlocutory appeal, this ruling was reversed by the court of appeals in the order of which peti-

3. Neither decision has been reported. A portion of the February 5, 1974 decision, which includes the district court's rationale with respect to the issue now in dispute, is reproduced in the Petition for Certiorari, at A14-A66.

tioners now seek review. Petition for Certiorari, at A1-A12. The court of appeals held that the immunity accorded to opinion work product by Rule 26(b)(3) is unqualified, and does not end as soon as the litigation for which the materials are prepared is over. The court of appeals again remanded the matter to the district court, directing it to produce discoverable material, if any, to the petitioners, but to protect against disclosure of mental impressions, conclusions, opinions, and legal theories. Redacting and abstracting the documents were suggested as possibilities. Thus, the court of appeals' order is not only non-final in the sense that it did not terminate the litigation; it did not even finally decide the discovery dispute.

Argument

Certiorari should be denied. Petitioners seek review of an interlocutory order which is clearly correct and is not in conflict with the decisions of this or any other court. There can be little doubt that opinion work product is immune from discovery under Rule 26(b)(3); but in any event, this is not the right case for this Court to consider this issue. The court of appeals decision can be sustained on the alternative ground that no circumstances here exist that even arguably justify discovery of opinion work product.

I

This case does not justify a departure from the usual rule against review of interlocutory orders on certiorari.

This Court does not grant certiorari to review interlocutory orders, absent extraordinary circumstances. *Firemen* v. *Bangor & A. R. Co.*, 389 U.S. 327, 328 (1967):

> "Petitioners seek certiorari to review the adverse rulings made by the Court of Appeals. However, because the Court of Appeals remanded the case, it is not yet ripe for review by this Court. The petition for a writ of certiorari is denied. See *Hamilton Shoe Co.* v. *Wolf Brothers*, 240 U.S. 251, 257-258 (1916)."

See *Goldstein* v. *Cox*, 369 U.S. 471, 487 (1970); *American Construction Co.* v. *Jacksonville, T. & K.W.R. Co.*, 148 U.S. 372, 384 (1893).

No extraordinary circumstances exist here. On the contrary, the already long delay in reaching trial, and the absence of a final ruling even on the discovery of materials contained in the 21 documents in issue, weigh heavily against granting this petition. To grant certiorari would impede progress of the litigation for many months, in order to consider a ruling whose impact on this litigation is still unresolved: that impact depends on what the district court does in response to the court of appeals' direction that it consider partial production, or the making of abstracts, of some of the documents, so that discoverable material, if any, will be produced to the petitioners.[4]

4. In addition to the 21 documents remanded to it for further consideration by the court of appeals, the district court still has before it a number of documents for which claims of privilege have been made and upon which it has not yet ruled.

II

The court of appeals decision is correct, and not in conflict with any decision of any other court.

Fed. R. Civ. P. 26(b) (3), promulgated in 1970, distinguishes between trial preparation materials that consist of opinion work product and those that do not. In the first sentence of the Rule, materials that do not contain opinion work product—for example, reports of witness interviews made in anticipation of litigation—are given qualified immunity, but will be discoverable

> "upon a showing that the party seeking discovery has substantial need of the materials in the preparation of his case and that he is unable without undue hardship to obtain the substantial equivalent of the materials by other means."

In the second sentence, opinion work product is given unqualified immunity. Such work product is not discoverable even where substantial need and undue hardship have been shown:

> "In ordering discovery of such materials when the required showing has been made, the court *shall protect* against disclosure of the mental impressions, conclusions, opinions, or legal theories of an attorney or other representative of a party concerning the litigation." (Emphasis added.)

A like distinction between opinion work product and other kinds of work product (*e.g.*, statements made by witnesses) is found in *Hickman* v. *Taylor*, 329 U.S. 495 (1947).

In *Hickman,* with respect to non-opinion work product, the Court wrote:

> "We do not mean to say that all written materials obtained or prepared by an adversary's counsel with an eye toward litigation are necessarily free from discovery in all cases. Where relevant and non-privileged *facts* remain hidden in an attorney's file and where production of those *facts* is essential to the preparation of one's case, discovery may properly be had." 329 U.S., at 511 (emphasis added).

On the other hand, the Court said that if the discovery rules were read to permit access to opinion work product,

> "An attorney's *thoughts,* heretofore inviolate, would not be his own. Inefficiency, unfairness and sharp practices would inevitably develop in the giving of legal advice and in the preparation of cases for trial. The effect on the legal profession would be demoralizing. And the interests of the clients and the cause of justice would be poorly served." 329 U.S., at 511 (emphasis added).

It is clear from *Hickman,* and still clearer from Rule 26(b)(3), that opinion work product must remain "inviolate."

In this case, the court of apepals, in a well reasoned opinion, did no more than to apply the distinction made in *Hickman* and in Rule 26(b)(3). Specifically, the court of appeals held that under Rule 26(b)(3), "no showing of relevance, substantial need or undue hardship should justify compelled disclosure of an attorney's mental impressions, conclusions, opinions or legal theories. This is made clear by the Rule's use of the term 'shall' as opposed to 'may.'" Petition for Certiorari, at A6.

As the court of appeals noted (Petition for Certiorari, at A8-A9), no case decided under Rule 26(b)(3) has reached a contrary conclusion. In accord with the court of appeals' decision are *Smedley* v. *Travelers Ins. Co.*, 53 F.R.D. 591, 593 (D.N.H. 1971); *Kennedy* v. *Senyo*, 52 F.R.D. 34, 37 (W.D. Pa. 1971); *Clower* v. *Walters*, 51 F.R.D. 288, 289 (S.D. Ala. 1970); *Crocker* v. *United States*, 51 F.R.D. 155, 156 (N.D. Miss. 1970). The court of appeals cited (Petition for Certiorari, at A8-A9) a number of pre-1970 cases which seemed to take a contrary view, but pointed out that most of the cases are distinguishable, and all are of doubtful authority, since they antedated Rule 26(b)(3). Indeed, a reading of the pre-1970 cases shows that only one, *McCullough Tool Co.* v. *Pan Geo Atlas Corp.*, 40 F.R.D. 490 (S.D. Tex. 1966), permitted discovery by an adversary of mental impressions concerning litigation.

The post-Rule 26(b)(3) cases relied on by petitioners are inapposite. *United States* v. *Brown*, 478 F. 2d 1038 (7th Cir. 1973), cited in the petition (at 13-14) for the proposition that there is a conflict in circuits, dealt with memorandums prepared to discuss the tax consequences of a contemplated business transaction. 478 F. 2d, at 1039. Since the memorandums were not prepared in anticipation of litigation or for trial, Rule 26(b)(3) was inapplicable to them. *Harper & Row Publishers, Inc.* v. *Decker*, 423 F. 2d 487 (7th Cir. 1970), aff'd by an equally divided Court, 400 U.S. 348 (1971), and *Xerox Corp.* v. *International Business Machines Corp.*, 64 F.R.D. 367 (S.D.N.Y. 1974), dealt with memorandums of witness interviews, the type of ordinary, non-opinion work product that is discoverable under Rule 26(b)(3) upon the required showing of substan-

tial need and undue hardship. 423 F. 2d, at 492; 64 F.R.D., at 375.

For the reasons stated in the court of appeals decision, opinion work product is immune from discovery under Rule 26(b)(3), and the cases uniformly so hold. This proposition is not sufficiently doubtful or disputed to warrant review by this Court.

III

The decision below may be supported on an independent ground.

The decision below is supported by an independent ground, not reached by the court of appeals, that precludes this Court from considering the issues posed by petitioners. This ground is that the second sentence of Rule 26(b)(3) expressly affords protection to opinion work product that is not afforded to non-opinion work product; and neither court below found or had a basis for finding any facts that would enable petitioners to overcome that protection.

The district court did not find that petitioners had made any showing beyond the "substantial need" and "undue hardship" that would permit discovery of non-opinion work product—transcripts of interviews with witnesses, for example. The district court thought that no greater showing was required for discovery of the draft briefs and other opinion work product at issue here because, in the district court's view, the distinction between opinion and non-opinion work product was erased by the termination of the prior litigations for which the documents

in dispute were prepared. In other words, the district court held that opinion work product is relegated to the status of non-opinion work product when a litigation ends. This holding ignores the difference between the first and second sentences of Rule 26(b)(3); it appears to be without support in the authorities; it was rejected by the court of appeals; and petitioners do not attempt to defend it here.[5]

Assuming, *arguendo*, that the second sentence of Rule 26(b)(3) does not mean what it says, and allows production of opinion work product upon a certain showing, such a showing must require more than what is necessary for the production of non-opinion work product under the first sentence of the Rule. Neither court below found that such a showing had been made; the petitioners do not claim to have made such a showing; and none can be found in the record.[6]

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5. Petitioners have previously chosen not to argue in this Court that *all* work product immunity ends with the end of the litigation for which documents were prepared. This issue was resolved by the court of appeals in its prior decision (Petition for Certiorari, at A67-A75), from which petitioners did not seek certiorari.

Moreover, petitioners were clearly correct in concluding that the issue raised in the prior appeal was unworthy of a petition for certiorari. The rationale underlying the work product doctrine is that no attorney or other representative of a party can perform his function in the adversary system if he fears that everything he puts in writing may be disclosed to present or future opponents. As the court of appeals held on the prior appeal, "the rationale is scarcely less applicable to a case which has been closed than to one which is still being contested." Petition for Certiorari, at A72.

6. In place of the required showing, petitioners advance the theory that the opinion work product at issue here consists of "operative facts." This theory ignores the distinction between the two sentences of Rule 26(b)(3) and would, as the court of appeals pointed out, require discovery of opinion work product merely upon a claim that opinions are relevant.

Therefore, affirmance of the order below would be required whether or not this Court agrees with the court of appeals' view of the law. *E.g., Dandridge* v. *Williams*, 397 U.S. 471, 475-476 & n.6 (1970); *Walling* v. *General Industries Co.*, 330 U.S. 545, 547 & n.5 (1947); *Swarb* v. *Lennox*, 405 U.S. 191, 202 (1972) (WHITE, J., concurring). The existence of an independent ground for affirmance requires denial of the petition for certiorari. Cf. *The Monrosa* v. *Carbon Black, Inc.*, 359 U.S. 180, 183-184 (1959).

Conclusion

For the reasons stated, the petition for a writ of certiorari should be denied.

Respectfully submitted.

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